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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,546	03/20/2001	Karl Kolter	51284	9100
26474 7590 11/05/2009 NOVAK DRUCE DELUCA + QUIGG LLP 1300 EYE STREET NW SUITE 1000 WEST TOWER WASHINGTON, DC 20005			EXAMINER SILVERMAN, ERIC E	
			ART UNIT	PAPER NUMBER
			1618	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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WASHINGTON DC 20005

In re Application of: :  
Kolter et al. :  
Serial No.: 09/811,546 : PETITION DECISION  
Filed: March 20, 2001 :  
Attorney Docket No.: 51284 :

This is in response to the petition filed September 24, 2009 under 37 CFR § 1.181, requesting that the finality of the Office action of September 17, 2009 be withdrawn.

#### BACKGROUND

The examiner mailed an Advisory Action on June 18, 2009. In this Advisory Action, the examiner indicated that the claim amendments filed after final Office action [on April 23, 2009] would not be entered because they raised new issues that would require further consideration and/or search (see box 3(a) of the Advisory Action form, PTOL-303).

On August 25, 2009, applicants filed a Request for Continued Examination (RCE) along with the appropriate fees. In this RCE, applicants specifically fulfilled the requirements of 37 C.F.R. § 1.114 (submission) by indicating that the submission was filed on May 21, 2009 and that said submission, containing claim amendments was to be considered for examination.

On September 17, 2009, the examiner mailed a final Office action setting a three month statutory limit for reply.

In response thereto, applicants filed this petition on September 24, 2009 under 37 CFR § 1.181, requesting that the finality of the Office action of September 17, 2009 be withdrawn.

#### DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed on September 24, 2009, applicants argue that the final Office action instituted by the Examiner on September 17, 2009 was improper and premature due to the fact that the examiner refused entry of the claim amendments after final Office action as indicated by the Advisory Action mailed by the examiner on June 18, 2009.

To support these contentions, applicants specifically cite MPEP § 706.07(b). MPEP § 706.07(h) (VIII) is cited as well :

MPEP 706.07(h) (VIII) states:

The action immediately subsequent to the filing of an RCE with a submission and fee under 37 CFR 1.114 may be made final only if the conditions set forth in MPEP 706.07(b) for making a first action final in a continuing application are met...

MPEP 706.07(b), third paragraph states:

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.

A review of the prosecution history of this case clearly shows that the examiner refused entry of the amendments filed after final Office action for raising new issues that would require a new consideration and/or search as indicated by the Advisory Action form. Made clearly evident by the MPEP, when a decision to refuse entry of an amendment filed after final Office action is made by the examiner due to an issue which would require a new consideration or search, the next action mailed by the examiner in reply to the filing of an RCE is *precluded from finality*.

Hence, applicants' points are well-taken and found persuasive. It is decided that the final Office action mailed on September 17, 2009 was, in fact, premature and in error. The finality of said rejection is hereby WITHDRAWN in favor of applicants.

## DECISION

The petition is **GRANTED**.

This application will be forwarded to the examiner for an action not inconsistent with this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

  
Remy Yucel  
Director, Technology Center 1600